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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,516	10/05/2005	Motoki Hiraoka	2886.0092-00000	5346
22852	7590	03/26/2010		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER BAREFORD, KATHERINE A	
			ART UNIT	PAPER NUMBER
			1792	
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			03/26/2010 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/530,516

**Applicant(s)**

HIRAOKA ET AL.

**Examiner**

Katherine A. Bareford

**Art Unit**

1792

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

#### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 5, 2010 has been entered.

The amendment filed with the RCE submission of January 5, 2010 has been received and entered. With the entry of the amendment, claims 4 and 8 are canceled, and claims 1-3, 5-7 and 9 are pending for examination.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were

made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. The rejection of claims 1, 5 and 9 under 35 U.S.C. 103(a) as being unpatentable over Ogisu et al (Japan 08-092752, hereinafter Ogisu) in view of Harada et al (Japan 01-092377, hereinafter Harada), Hattori et al (Japan 11-244360, hereinafter Hattori) and Inoue (Japan 55-145620, hereinafter Inoue) is withdrawn due to the newly required features of the claims after the amendment of January 5, 2010.

5. Claims 1-3, 5-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asakura et al (Japan 10-088361, hereinafter Asakura) in view of Iwasa et al (US 5803131), Mayne (US 4437999), Hattori et al (Japan 11-244360, hereinafter Hattori) and Inoue (Japan 55-145620, hereinafter Inoue).

Claims 1, 5: Asakura teaches a method of pretreating before electroless plating (paragraph [0006]). A resin material is irradiated with ultraviolet rays before electroless plating to help increase adhesion of the plating, by helping to oxidize and degrade the surface of the polymer (paragraphs [0006] – [0009]). No roughening treatment is required on the surface of the resin before the UV treatment (paragraphs [0003], [0004],

[0010], [0015] and Table 1). After the UV treatment, electroless plating is provided. Paragraph [0014].

Asakura does not teach that the UV treatment is done while the resin material is in contact with a first solution containing ozone and a specific solvent as claimed. However, Iwasa teaches that a polymer surface can be desirably oxidized to prepare the surface for electroless plating by contacting the surface with an aqueous ozone solution (column 9, lines 45-65, column 10, lines 10-15, column 11, line 65 through column 12, line 35). Mayne further teaches that it is well known that simultaneously treating an organic resin material with a first solution containing ozone and UV light has the physical effect of oxidizing the resin, with the ultraviolet light serving to enhance appreciably the oxidation rate accomplished by the ozone (column 1, lines 5-20 and 55-65, column 2, lines 35-45, and column 4, lines 45-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Asakura to further provide that the resin material is in contact with an ozone solution as suggested by Iwasa and Mayne during the UV irradiation to provide a beneficial increased oxidation rate for speedy processing, as Asakura and Iwasa both teach the desire to oxidize resin surfaces before electroless plating, using UV treatment and an ozone solution, respectively, and Mayne teaching that the combination of these treatments would be expected to provide a beneficial enhanced oxidation rate.

As to the further use of the specific solvent other than water, Hattori teaches that by further providing an organic solvent, such as alcohol, for example, ethanol, with

water in an ozone containing solution its oxidative powers are increased for use in treating polymers (see the Abstract and paragraphs [0004] – [0005], [0007], [0012], [0025]). Paragraph [0012] and Figure 1 of Hattori notes that when ethanol concentration is more than 10 volume % the solubility of ozone increases over that of water alone and this ozone level corresponds to oxidizing power. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Asukura in view of Iwasa and Mayne to further provide organic alcohol, such as ethanol (an organic polar solvent) in a concentration of more than 10 volume % to increase the solubility (dissolvability) of the ozone and increase the oxidizing power of the solution as taught by Hattori in order to further accelerate and increase the oxidation step. As worded in the claim, the presence of this ethanol would provide that at least some of the ozone would dissolve in the ethanol that is present, due to its solubility in ethanol, and therefore, even if water is also present, a solution containing ozone dissolved in a organic polar solvent that is not water would be provided. Moreover, it is also the Examiner's position that it would have been obvious from the teaching of Hattori to perform routine experimentation to optimize the amount of ethanol used, up to 100 volume % (all ethanol/no water) to provide the optimum oxidation ability given the teaching of Hattori of increasing ozone solubility with increasing percentage of ethanol, showing that the amount of ethanol is a result effective variable, and "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine

experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Furthermore, Inoue teaches that conventional use of either ethanol or methanol as an alcohol used to provide a oxidizing agent with ozone (abstract). It further would have been obvious to modify Asakura in view of Iwasa, Mayne and Hattori to use methanol as to the organic alcohol instead of ethanol as suggested by Inoue with an expectation of similar results because Hattori teaches to use an organic alcohol solvent, exemplifying ethanol, and Inoue teaches that methanol would be an organic alcohol used for a similar purpose and with an expectation of similar results as ethanol for providing an ozone containing solution.

Although applicant asserts unexpected results summarized in Table 1 of the specification, these results are not commensurate in scope with these claims to show that the results occur over the entire claimed range (see MPEP 716.02(d)). For example (1) applicant's table provides one example of nitric acid (and does not say how much/strength is used -- i.e. is the solution 100% nitric acid, 60% nitric acid/40% water, etc.) and one example of ethanol (and does not say if this is entirely ethanol), while applicant's claims claim a specific list of organic or inorganic polar solvents (that does not include ethanol) with no indication that the same results will occur for every inorganic/organic solvent listed; (2) applicant claims a resin material in general can be treated, but only uses an ABS substrate in the examples, with no indication that the same results will occur for every resin.

Claims 2-3 and 6-7: Asakura further teaches that after the UV treatment, the resin material is brought into contact with a second solution containing an alkaline component and a nonionic surface active agent (surfactant) to help improve plating adhesion (paragraphs [0005] – [0006], [0011] and [0013]).

Claim 9: After the electroless plating step, Asakura indicates that an electroplating step can be provided (paragraph [0017]). Iwasa further indicates that it is conventional to provide an electroplating step after electroless plating (column 10, lines 10-15).

#### *Response to Arguments*

6. Applicant's arguments with respect to claims 1-3, 5-7 and 9 have been considered but are moot in view of the new ground(s) of rejection.

The new combination of references provided, with the addition of Iwasa and Mayne, provides the suggestion of UV and ozone solution treatment in combination. Asakura as cited above does not require “prior roughening” treatment before the UV treatment.

#### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (571) 272-1413. The examiner can normally be reached on M-F(6:00-3:30) First Friday Off.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Katherine A. Bareford/  
Primary Examiner, Art Unit 1792